

REMARKS

At the time of the First Office Action dated October 14, 2008, claims 1-4 and 6-17 were pending and rejected in this application.

CLAIMS 1-4 AND 6-7 ARE REJECTED UNDER 35 U.S.C. § 101

On pages 2 and 3 of the First Office Action, the Examiner asserts that the claimed invention, as recited in claims 1-4, 6-7, fails to meet the requirements of 35 U.S.C. § 101. This rejection is respectfully traversed. Specifically, the Examiner asserted:

Claims 1-4, 6-7 are rejected pursuant to 35 U.S.C. 101 as being "directed to System which as disclosed in specification (par. 0028-0029) as hardware, software or a combination of hardware and software, which is neither a 'process' nor a 'machine,' but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. 101 which is drafted so as to set forth statutory classes of invention in the alternative only. Id. At 1551. (See MPEP 2173.05(p)(II) PRODUCT AND PROCESS IN THE SAME CLAIM.

At the outset, Applicants note that the Examiner has failed to set forth any analysis to support the Examiner's conclusory statement that claim 1 is directed to non-statutory subject matter. Thus, the Examiner has failed to establish a prima face case under 35 U.S.C. § 101. Notwithstanding the Examiner's lack of analysis, claim 1 recites, in part "a Web conference provisioning system" that includes "a policy manager coupled to at least two different Web conferencing platforms over a computer communications network", where "said policy manager has a configuration for processing a policy set forth in a policy document." Accordingly, the Applicant's claimed Web conference provisioning system has sufficient defined structure to meet the requirements of 35

U.S.C. § 101. Claims 2-4 and 6-7 depend directly or indirectly from independent Claim 1 and thus for at least the above reasons also meet the requirements of 35 U.S.C. § 101.

With regard to the Examiner's rejection stated on page 3 of the Office Action, the Examiner is invited to read the case law discussed within M.P.E.P. § 2173.05(p). The claims at issue are not directed to two statutory classes of subject matter – they are directed to a device. The claims discussed in the case law claimed, within the preamble both a device and a method for using the devices. This is not analogous to the present claims. Also, the Examiner's reliance upon the specification is inappropriate since the claims define the invention, not the specification.

CLAIMS 1-4 AND 6-17 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON GUDJONSSON ET AL., U.S. PATENT NO. 6,564,261 (HEREINAFTER GUDJONSSON) IN VIEW OF NGUYEN, U.S. PATENT PUBLICATION NO. 2003/0172145 (HEREINAFTER NGUYEN)

On pages 4 through 26 of the First Office Action, the Examiner concluded that one having ordinary skill in the art would have considered the claimed invention to be obvious in view of Gudjonsson and Nguyen. This rejection is respectfully traversed.

On October 10, 2007, the Patent Office issued the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in KSR International Co. v. Teleflex Inc.," 73 Fed. Reg. 57,526 (2007) (hereinafter the Examination Guidelines). Section III is entitled "Rationales To Support Rejections Under 35 U.S.C. 103."

Within this section is the following quote from the Supreme Court: "rejections on obviousness grounds cannot be sustained by merely conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Referring to the first column on page 57,529 of the Examination Guidelines for Determining Obviousness, the following is a list of rationales that may be used to support a finding of obviousness under 35 U.S.C. § 103:

(A) Combining prior art elements according to known methods to yield predictable results;

(B) Simple substitution of one known element for another to obtain predictable results;

(C) Use of known technique to improve similar devices (methods, or products) in the same way;

(D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;

(E) "Obvious to try" - choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;

(F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;

(G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Referring to the paragraph entitled "Office Personnel as Factfinders" on page 57,527 of the Examination guidelines, the following was stated:

Office personnel fulfill the critical role of factfinder when resolving the *Graham* inquiries. It must be remembered that while the ultimate determination of obviousness is a legal conclusion, the underlying *Graham* inquiries are factual. When making an obviousness rejection, Office personnel must therefore ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied. In certain circumstances, it may also be important to include explicit findings as to how a person of ordinary skill would have understood prior art teachings, or what a person of ordinary skill would have known or could have done. Factual findings made by Office personnel are the necessary underpinnings to establish obviousness.

In Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), the Supreme Court set forth the factual inquiries that are to be applied when establishing a background for determining obviousness under 35 U.S.C. 103. These factual inquiries are summarized as follows:

- (A) Determine the scope and content of the prior art;
- (B) Ascertain the differences between the prior art and the claims at issue;
- (C) Resolve the level of ordinary skill in the pertinent art; and
- (D) Evaluate any indicia of nonobviousness.

However, in order to make a proper comparison between the claimed invention and the prior art, the language of the claims must first be properly construed. See In re Paulsen, 30 F.3d 1475, 1479 (Fed. Cir. 1994). See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, "what is the invention claimed?" since "[c]laim interpretation, ... will normally control the remainder of the decisional process.") See Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

At paragraphs (c and f) of pages 9 and 10 of the First Office Action, the Examiner states:

e. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Gudjonsson's Operator of Cluster providing Web conferencing services, to that of Nguyen's Internet service provider Architecture which provides configuration guidelines in its implementation of providing Web services. Systems are preferably easier to manage because of the ability to set and enforce policies that control how system resources are utilized, preferably ensuring that customers will receive the assigned service level within a shared resource environment.

f. The motivation would have been for an effective and particularly for a way to more effectively utilize resources by virtue of dynamic aggregation and configuration of web conferencing services and efficiently providing the requested web conferencing services to the user device.

Turning to the specifics of the rejection, the Examiner fails to identify either the rationale being employed or where any of the specifically claimed limitations are specifically found within Gudjonsson and Nguyen. In this regard, the Examiner has clearly failed to meet the requirements set forth in the Examination Guidelines for Determining Obviousness.

Applicant respectfully disagrees with the Examiner's assertion that one of ordinary skill in the art would be reasonably compelled to combine "Gudjonsson's Operator of Cluster with Nguyen's Internet service provider Architecture" to arrive at the Applicant's claim invention. Moreover, the stated motivation to combine is merely a statement of Applicant's claimed invention. In this sense, the Examiner is using Applicant's disclosure as the rationale for controlling the selection of web conferencing services on two different platforms in an efficient matter. This is merely impermissible hindsight and therefore an improper "motivation" to combine the Gudjonsson and Nguyen references. The Examiner's misanalysis notwithstanding, each of claims 1-4 and 6-7 recite a policy manager having a configuration for processing a policy set forth in a policy document and for processing a request for a Web conferencing from a

communicatively linked end user to select one of said Web conferencing platforms to host said Web conference. At paragraph (c), lines 1-2, the Examiner has clearly acknowledged that Gudjonsson “does not that policy manager having a configuration for processing a policy.” (underline added). Moreover, Gudjonsson does not disclose that the policy is set forth in a policy document, which policy is for processing a request for a Web conferencing.

Turning to the Nguyen reference and upon review, Applicant has been unable to discover any teaching of a policy manager having a configuration for processing a policy set forth in a policy document. Specifically, the Examiner makes no analysis of where the Nguyen reference discloses Applicant’s recited “a policy set forth in a policy document”. Thus, the Examiner analysis has improperly characterized the scope and content of the applied prior art by asserting that Nguyen teaches these limitations. Based on the teachings of the Examiner’s cited passage, Applicant’s position is that Nguyen fails to teach all the limitations of claims 1-4 and 6-7.

Claims 8 and 13

Independent claims 8 and 13 recite, in part, “establishing criteria for a proposed Web conference, and applying at least one policy to said criteria to identify a platform for hosting said proposed Web conference.”

To teach this limitation, the Examiner cited col. 1, lines 12-15 of Gudjonsson. For ease of reference, the Examiner’s cited passages are reproduced below:

This invention is related to a system and corresponding method of establishing communication session(s) between users as a function of their availability and/or communication device(s).

Applicant submits that the cited passage fails to disclose “applying at least one policy” as recited in independent claim 8, as known to one of reasonable skill in the art, and discussed in Applicant’s specification. More specifically, a “policy can specify a platform selection based upon Web conference criteria, [which] ... can include a number of participants to the Web conference, whether the participants are internal or external to a private network of the end user, ... a priority of the Web conference” (lines 2-9 of paragraph [0011] of Applicant’s specification).

Claims 9-11 and 14-17

Dependent claims 9-11 and 14-17 refer to independent claims 8 and 13, respectively. Specifically, claims 9 and 14 refer to “resolving an address to said identified platform, imbedding said address in an invitation to participate in said proposed Web conference, and forwarding said invitation to selected participants in said proposed Web conference.” To teach these limitations, the Examiner cited col. 3, lines 14-27 and lines 28-36 of Gudjonsson. For ease of reference, the Examiner’s cited passages are reproduced below:

The routing service allows users to send invitations to other users to establish an arbitrary communication session (e.g., text chat session, voice chat session, web conference, etc.) over arbitrary networks. The requests are not sent directly between users. Instead, the routing service for the sending/inviting user sends the invitation to the routing service for the receiving user. The routing service for the receiving user determines, according to a logic specified by the same receiving user, how the request is handled and what services are available to handle the request. For example, the routing service for the receiving user may forward the invitation to the receiving user’s client, may ignore the invitation, may forward the invitation to the receiving user’s mobile phone, or may forward the invitation to the receiving user’s inbox so that the user may later read the invitation.

The cluster and services within it make the necessary minimum setup for the session to be established, and **thus no network addresses need to be exchanged between the users**, thus retaining the anonymity of the users. As users can be software entities as well as persons, the system allows communication sessions between users and arbitrary data services. In certain embodiments, the system does not need a central database of all users to function, but clusters can forward requests to other clusters, and thus insure the connectivity of all clusters within the system. (emphasis added)

The cited passage of Gudjonsson fails to disclose “imbedding said address in an invitation to participate in said proposed Web conference.” To the contrary, the cited passage of Gudjonsson appears to teach that no imbedded “network addresses [are] exchanged between the users. Based on the teachings of the Examiner’s cited passage, Applicant’s position is that Gudjonsson fails to teach all the limitations of claims 9 and 14.

Moreover, dependent claims 10-12 and 15-17 refer to independent claims 8 and 13, respectively. Specifically, claims 10 and 15 refers to “re-establishing said criteria, and applying said at least one policy to said re-established criteria to identify a different platform for hosting said proposed Web conference.” To teach these limitations, the Examiner cited col. 3, lines 14-27 and lines 28-36 of Gudjonsson as shown above. Applicant, however, is unclear as to the exact teaching that correspond to the claimed “re-establishing said criteria, and applying said at least one policy to said re-established criteria to identify a different platform for hosting said proposed Web conference.” Based on the teachings of the Examiner’s cited passage, Applicant’s position is that Gudjonsson fails to teach all the limitations of claim 10-12 and 15-17.

For above-described reasons, the Examiner has failed to establish that the claimed invention, as recited in claims 1-4 and 6-17 would have been obvious within the meaning of 35 U.S.C. § 103. Applicant, therefore, respectfully submits that the imposed rejection of claims 1-4 and 6-17 under 35 U.S.C. § 103 for obviousness based upon Gudjonsson and Nguyen is not viable and, hence, Applicant solicits withdrawal thereof.

Applicant has made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicant invites the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicant hereby respectfully requests reconsideration and prompt allowance of the pending claims.

Although Applicant believes that all claims are in condition for allowance, the Examiner is directed to the following statement found in M.P.E.P. § 706(II):

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible should offer a definite suggestion for correction.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500563, and please credit any excess fees to such deposit account.

Respectfully submitted,

Date: January 14, 2009

/Scott D. Paul/

Scott D. Paul
Registration No.: 42,984
Adam C. Underwood
Registration No. 43,169
Customer Number 46321
Tel: (561) 922-3845